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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/895,950 07/17/97 WINTER

A HOE-90/F-333

IM62/0824

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EXAMINER

TESKIN, F

ART UNIT

PAPER NUMBER

1713

DATE MAILED:

08/24/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
**08/895,950**

Applicant(s)  
**Winter, et al.**

Examiner  
**Fred Teskin**

Group Art Unit  
**1713**



☒ Responsive to communication(s) filed on Jun 21, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three (3) month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-15 and 19-26 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-15 and 19-26 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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1. The response filed June 21, 2000 has been fully considered with the following effect:

(i) the enclosed copy of the declaration filed in reissue application no. 08/324,260 averring loss or inaccessibility of the original patent is acceptable in lieu of the original patent;

(ii) the prior art rejection based primarily on Japanese 62-121707 is withdrawn in view of the amendment excluding the possibility of  $R^3$  being methyl in the three independent claims (claims 1, 7 and 19) and the comparative examples in the patent specification which demonstrate that substitution at the 2-position of an indenyl ligand as per the claimed invention has a positive and unexpected effect on the melting point of polypropylenes prepared by polymerizing with the corresponding 2-substituted metallocenes;

(iii) claims 1-15 and 19-26 are subject to new grounds of rejection under § 112 as detailed below.

2. Claims 1-15 and 19-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More specifically, the following grounds for indefiniteness apply to the indicated claims.

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(A) Claims 1, 7 and 19 are inaccurate due to an obvious error in formula (I):  $R^7$  is shown as bonded directly to  $R^8$  instead of to the carbon atom of the  $(CR^8R^9)_n$  grouping. Appropriate correction is required.

(B) Claim 19 is indefinite due to lack of definition for the variables "A" and "p" in formula (I). Appropriate correction is required.

3. Claims 1-6, 8-15 and 19-26 are rejected under 35 U.S.C. 112, first paragraph, as the specification does not contain a written description of the claimed invention, in that the disclosure does not reasonably convey to one skilled in the relevant art that the inventor(s) had possession of the claimed invention at the time the application was filed.

Specifically, the subject matter of the phrase " $R^3$  is ... a  $C_6$ - $C_{10}$ -aryl group, which is optionally halogenated" (see the definition of  $R^3$  in claims 1, 19, 25 and 26) lacks adequate descriptive support in the patent specification. Applicants have not pointed out wherein the specification describes this subject matter and the examiner has independently found no description, express or implied, of a *halogenated*  $C_6$ - $C_{10}$ -aryl group as a possible choice for the  $R^3$  substituent of the claimed compound.

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4. In view of the fact that additional errors in the original patent have been corrected through amendments to the claims and all of the additional errors corrected were not spelling, grammar, typographical, editorial or clerical errors (note, e.g., the amendment noted in item 1(ii) *supra*), a supplemental oath or declaration complying with 37 CFR 1.175(b)(1) is required. See *In re Constant*, 3 USPQ2d 1479.

5. Applicant is notified that any subsequent amendment to the specification and/or claims must comply with 37 C.F.R. § 1.121(b).

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the

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advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner F. M. Teskin whose telephone number is (703) 308-2456.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached on (703) 308-2450. The appropriate fax phone number for the organization where this application or proceeding is assigned is (703) 305-3599.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

FMTeskin/08-20-00

  
FRED TESKIN  
PATENT EXAMINER  
ART UNIT 1551713